IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Alberth, Jr. et al.
For:	Method and Apparatus for Storing a Message for Playback during a User-Initiated Emergency Telephone Call from a Wireless Device
Serial No.:	09/610,768
Filed:	July 6, 2000
Examiner:	Tran, T.
Art Unit:	2684

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Board of Patent Appeals and Interferences

APPELLANTS' BRIEF

This brief is in furtherance of the Notice of Appeal, mailed on January 9, 2004.

The fees required under § 1.17, and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief is being transmitted by facsimile, and therefore the requirement that it be transmitted in triplicate is believed to be waived.

This brief contains these items under the following headings, and in the order set forth below (37 C.F.R. § 1.192(c)):

I REAL PARTY IN INTEREST

II RELATED APPEALS AND INTERFERENCES

I. REAL PARTY IN INTEREST

The real party in interest in this appeal is Motorola, Inc., a Delaware corporation.

II. RELATED APPEALS AND INTERFERENCES

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal, there are no such appeals or interferences.

III. STATUS OF CLAIMS

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 28

B. STATUS OF ALL THE CLAIMS

1. Claims canceled: 3 and 25
2. Claims withdrawn from consideration but not canceled: none
3. Claims pending: 1, 2, 4-24 and 26-30
4. Claims allowed: 5-10, 14-24, 27 and 30
5. Claims objected to: none

6. Clams rejected: 1, 2, 4, 11-13, 26, 28 and 29

C. CLAIMS ON APPEAL

The claims on appeal are: 1, 2, 4, 11-13, 26, 28 and 29

IV. STATUS OF ANY AMENDMENTS AFTER FINAL

No amendments have been filed after final.

V. SUMMARY OF INVENTION

The invention pertains to a wireless device, and a method for sending a message stored in the memory of the wireless device. The claimed device and method has particular relevance to emergency messages being transmitted during emergency situations, such as user initiated emergency calls (page 1, lines 2-5).

In at least one instance, when a call associated with sending a message is initiated by the user, a timer is initiated, which delays sending the message until a predetermined time has elapsed as detected by the timer (page 8, lines 12-19). This allows for a period of time, which exists before the message is sent, in which the anticipated delivery of the message can be avoided (page 2, lines 23-27). In the same or alternative instances, once the call associated with transmitting a message has been initiated, the actual sending of the message can be avoided or interrupted when an audio signal, such as the user's voice, is detected from an external source, such as via the microphone of the wireless device (page 2, lines 28-32; page 8, lines 19-22). Still further in the same or other instances, the detection of the activation of a key can also be used to interrupt or terminate the sending of the stored message (page 9, lines 3-6).

Where the message is a data message, which includes emergency information, the message can additionally include a digital signature (page 11, line 35 to page 12, line 1).

VI. ISSUES

1. Whether claims 4 and 12 have been improperly rejected under 35 U.S.C. 102(b) as being anticipated by Alpert (US Patent No. 5,742,666).

2. Whether claims 1, 2, 13, 26, 28 and 29 have been improperly rejected under 35 U.S.C. 103(a) as being unpatentable over Alpert (US Patent No. 5,742,666) in view of Shirk et al. (US Patent No. 6,539,301).

3. Whether claim 11 has been improperly rejected under 35 U.S.C. 103(a) as being unpatentable over Alpert (US Patent No. 5,742,666).

VII. GROUPING OF CLAIMS

Group 1:	Claim 4
Group 2:	Claim 12
Group 3:	Claims 1, 2, 13, 26 and 29
Group 4:	Claim 28
Group 5:	Claim 11

VIIIA. ARGUMENTS -- REJECTIONS UNDER 35 U.S.C. § 102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Examiner has rejected claims 4 and 12 as being anticipated by Alpert (US Patent No. 5,742,666). However contrary to the Examiner's assertions, Alpert, '666, fails to make known each and every element as set forth in independent claims 4 and 12, and correspondingly each of the associated dependent claims. More specifically Alpert, '666, minimally fails to make known or obvious "not sending the stored message from the wireless device if audio signals are detected being picked-up by the microphone of the wireless device" (claim 4), and similarly fails to make

known "terminating sending the stored message when an audio signal is picked-up by a microphone of the wireless device" (claim 12).

In attempting to suggest that Alpert, '666, teaches the same, the Examiner has focused on two sections of the published patent reference. However, neither of the two cited sections (col. 5, lines 20-23, and col. 10, lines 43-46) support the Examiner's conclusion. More specifically, the first phrase (reproduced below) has no relevance as to the activities, in so far that it fails to identify the conditions in which the message would not be sent (claim 4), or might otherwise be terminated (claim 12), but only suggests that the user is allowed to interrupt the transmission.

> "The cellular telephone also allows the user to interrupt the transmission of the prerecorded emergency message so that the user may provide his or her own message." Alpert, '666, col. 5, lines 20-23

As noted previously, no cause for the interruption in this particular phrase is identified.

The second phrase similarly fails to make known the above noted claim features. In attempting to apply the phrase to the claims of the present application, it would appear that the Examiner is taking the phrasing out of context, in an attempt to suggest that it teaches something other than what it really teaches. Again, the corresponding phrase is reproduced below.

> "A sequence detector programmed into the control unit 70 will detect the interrupt sequence and allow the user to override the transmission of the emergency message by speaking into the microphone." Alpert, '666, col. 10, lines 43-46

As opposed to supporting a suggestion that the phrase makes known the above noted corresponding features from the claims, where an audio signal is detected and correspondingly in the stored message not being sent or the sending of the stored message being terminated, the cited phrase from Alpert, '666, more correctly teaches or suggests an interruption, which is effected as a result of the detection of the appropriate key or sequence of keys being depressed. This is made even more clear when read in the surrounding context. For example, immediately preceding the cited phrase, the reference recites "In order to interrupt the emergency message, the user simply depresses the appropriate key or sequence of keys on the handset 52 as described

above." (col. 10, lines 40-43). Correspondingly, contrary to the Examiner's assertion, the playing of the message is interrupted by the appropriate key or key sequence. This is consistent with at least one other portion of the reference, where the reference further recites that "The user can interrupt the prerecorded message and provide his or her own message by pressing a predetermined interrupt code. Such a code can be a single function key or a sequence of keys." (col. 6, lines 43-46). As a result, in a more proper context, the second phrase more correctly alternatively suggests that it is after the sequence detector, in conjunction with the control unit, detects the interrupt sequence, that the user is able to override or replace the transmission of the emergency message by speaking into the microphone.

Because the reference fails to teach or suggest "not sending the stored message from the wireless device if audio signals are detected being picked-up by the microphone of the wireless device" (claim 4), and similarly fails to make known "terminating sending the stored message when an audio signal is picked-up by a microphone of the wireless device" (claim 12), Alpert, '666, fails to teach or suggest each and every feature of the claims, and correspondingly cannot be said to anticipate either of the claims.

Still further, relevant to claim 4, it is not clear that the interruption of a message can be said to be the same thing as not sending a message.

The applicants would respectfully request that the rejections of claims 4 and 12 be correspondingly reversed, in view of the above noted deficiencies, and that the claims be permitted to proceed to allowance.

VIIIB. ARGUMENTS -- REJECTIONS UNDER 35 U.S.C. § 103

The Examiner has rejected claims 1, 2, 11, 13, 26, 28 and 29 under 35 U.S.C 103(a) as being unpatentable over Alpert, '666, either separately or in view of Shirk et al., US Patent No. 6,539,301. However, in each instance, the rejection has been misapplied. The specific reasoning outlining the misapplication of the rejection is noted below.

The Federal Circuit has repeatedly emphasized that, with respect to obviousness, the standard for patentability is the statutory standard. The inquiry is whether the claimed subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art. In this regard, see for example, Monarch Knitting Machinery Corp. v. Saulzer Maurat GMBH, 139 F.3d 877, 881, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998).

For purposes of formulating an obviousness type rejection, the Patent and Trademark Office (PTO) has the initial burden of presenting a prima facie case. In re Mayne, 104 F.3d 1339, 1341, 41 USPQ2d 1451 (Fed. Cir. 1997). In order to establish a prima facie case of obviousness, it must be shown that the prior art reference, or references when combined, teach or suggest all of the claim limitations. Pro-Mold and Tool Co. v. Great Lakes Plastics Inc., 75 F.3d 1568, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996), In re Royka, 490 F.2d 981, 180 USPQ 580, 583 (CCPA 1974). Furthermore, the showing of a suggestion, teaching, or motivation to combine prior teachings "must be clear and particular." In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). These requirements are consistent with the Patent and Trademark Office's own examination guidelines governing the formation of obvious type rejections, see MPEP §2142.

More specifically, relative to claims 1, 2, 13, 26, 28 and 29, which the Examiner rejects as being unpatentable over Alpert, '666, in view of Shirk et al., '301, the Examiner correctly notes that Alpert, '666, fails to make known sending the stored message when a predetermined time has elapsed on a timer, where the timer is initiated when the call is established. However, the Examiner incorrectly asserts that the timer taught or suggested by Shirk et al., '301, is the same or equivalent to the timer provided for in the claims of the present application. More specifically, Shirk et al., '301, includes a timer which is used to insure that a request button is actuated for a minimum period of time before the request is initiated (i.e. before the call is established). In other words, the timer in Shirk et al., '301, is more closely associated with a determination as to when the actuation of a button is sufficiently long for detecting a request to initiate a call, which occurs prior to the call being established.

As a result, Shirk et al., '301, fails to teach and/or suggest a timer which is initiated when the call is established, as provided in the claims. In at least one instance of the present application, initiating a timer when the call is established can be used to enable the message playback to be delayed for a predetermined period of time after an emergency call is established, during which time the user can prevent the message playback from occurring by speaking into

the phone or activating the appropriate key(s). Correspondingly, contrary to the Examiner's assertions, Alpert, '666, and Shirk et al., '301, either alone or in combination fail to make known or obvious each and every feature of claims 1, 2, 13, 26, 28 and 29 of the present application. As a result, claims 1, 2, 13, 26, 28 and 29 have been improperly rejected.

Still further with respect to claim 28, for the reasons noted above in connection with claim 12, claim 28 is similarly not made known or obvious by the cited references, in so far as claim 28 includes a controller which is programmed to "terminate transmission of the stored message when a voice signal is picked-up by a microphone of the wireless device".

Lastly, with respect to claims 11, which has been rejected under 35 U.S.C. 103(a) as being unpatentable over Alpert, '666, wherein the Examiner asserts that the inclusion of a digital signature in a data file is well known. The Examiner has failed to provide any motivation as to why the same would be obvious in the present context, wherein the additional reference which was cited as suggesting that the general principle is well known, generally relates to a digital signature which is obtained by encrypting the data or message with the secret key of the user at the sending terminal for purposes of security (i.e. avoid wire tapping).

In the present context, the digital signature is associated with the data message including emergency information, which in at least some embodiments of the present invention insures the legitimacy and correspondingly in at least some instances potentially enables an event to have a legal effect, which might be especially important in circumstances involving an at least partially automated response. This is especially true, where the triggering of the at least partially automated response might imply an emergency condition in which the user can not otherwise respond, which might make the legally established effect of a digital signature associated with the data message relevant.

More importantly, the Examiner has failed to associate any motivation, which is identified in a cited reference and/or correspondingly the prior art, which would suggest that one would have been led to include a digital signature with the messages being transmitted in the context of Alpert, '666, in a manner which would make known or obvious the features of the present invention. Furthermore, the vague and general assertions being made in support of the rejection can not be said to make known or obvious the feature in connection with the claims of

the present application. Because the Examiner has failed to properly establish a proper motivation to incorporate a digital signature in a context consistent with the cited reference, the corresponding rejection should be reversed.

In view of the above analysis, the applicants would assert, that the Examiner has failed to establish that any of the cited references either separately or in combination make known or obvious any of the presently pending claims. The applicants would respectfully request that the Examiner's decision to finally reject the presently pending claims be overturned, and that the claims be permitted to proceed to allowance.

Respectfully submitted,

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IX APPENDIX OF CLAIMS

The following is the text of the claims involved in this appeal:

1. A method for sending a message stored in memory associated with the wireless device, comprising:

a) initiating a call from the wireless device;

b) initiating a timer when the call is established; and

c) sending the stored message from the wireless device when a predetermined time has elapsed on the timer.

2. The method of claim 1, further comprising:

d) sending position data from the wireless device when the call is established.

3. (Canceled)

4. A method of sending a message stored in memory associated with a wireless device, the wireless device including a microphone, the method comprising the steps of:

a) initiating a call from the wireless device;

b) monitoring the microphone for audio signals; and

c) sending the stored message from the wireless device after a call is established; and

d) not sending the stored message from the wireless device if audio signals are detected being picked-up by the microphone of the wireless device.

5. A method of sending a message stored in memory associated with a wireless device, the wireless device including a microphone, the method comprising the steps of:

a) initiating a call from the wireless device;

b) monitoring the microphone for audio signals;

c) sending the stored message from the wireless device after a call is established; and

d) adding audio signals picked-up by the microphone of the wireless device into the stored message and sending the resultant combined signal.

6. A method of sending a message stored in memory associated with a wireless device, the wireless device including a microphone, the method comprising the steps of:

a) initiating a call from the wireless device to a base;

b) sending the stored message from the wireless device to the base after a call is established;

c) detecting a playback command received from the base, in response to the operator of the base depressing a keypad key; and

d) resending the stored message from the wireless device responsive to detecting the command received from the base.

7. The method of claim 6, wherein step a) comprises

detecting actuation of a speed-dial key and initiating the call from the wireless device in response to detecting actuation of the speed-dial key.

8. The method of claim 5, and further including the step of storing an audio message picked-up from a microphone of the wireless device in a memory associated with the wireless device after initiating the call.

9. The method of claim 5, further including the step of storing a data message in a memory associated with the wireless device.

10. The method of claim 9, wherein the data message is part of a radio repertoire.

11. A method of sending a message stored in memory associated with a wireless device, the wireless device including a microphone, the method comprising the steps of:

a) storing a data message including emergency information in the memory, the data

message additionally including a digital signature;

b) initiating an emergency call from the wireless device to a base; and

c) sending the stored message from the wireless device to the base after the emergency call is established.

12. A method of sending a message stored in memory associated with a wireless device, the wireless device including a microphone, the method comprising the steps of:

a) initiating a call from the wireless device;

b) monitoring the microphone for audio signals;

c) sending the stored message from the wireless device after a call is established; and

d) terminating sending the stored message when an audio signal is picked-up by a microphone of the wireless device.

13. The method of claim 1, further including terminating sending the stored message when a key of the wireless device is activated.

14. A method for sending a message from a wireless device, including a microphone, the method comprising the steps of:

a) initiating a call from the wireless device;

b) storing audio detected by the microphone upon initiating the call in a memory associated with the wireless device; and

c) upon establishing the call, sending the audio that was stored upon initiating the call.

15. The method of claim 14, further comprising:

d) sending position data from the wireless device once the call is established.

16. The method of claim 14, wherein step c) comprises the step of:

d) sending the stored message if voice signals are not detected via the microphone of the wireless device within a predetermined time after the call is established.

17. The method of claim 14, wherein step c) comprises the step of:

d) terminating sending the stored message if audio signals are detected via the microphone of the wireless device.

18. The method of claim 14, wherein step c) comprises the step of:

d) terminating sending the stored message when a key of the wireless device is activated.

19. The method of claim 14, further comprising:

d) resending the stored message from the wireless device when a command is detected on a downlink channel.

20. The method of claim 14, wherein step a) comprises the step of:

d) initiating a call from the wireless device by depressing a speed-dial key.

21. The method of claim 14, wherein step b) comprises the step of:

d) storing the message picked-up from a microphone of the wireless device in a memory associated with the wireless device.

22. The method of claim 14, wherein step b) comprises the step of:

d) if necessary, reallocating the memory to store the message.

23. A wireless device comprising:

a keypad;

a transceiver;

a memory, a message stored in the memory; and

a controller programmed to:

a) initiate a call from the wireless device in response to a predetermined key stroke;

b) transmit the stored message through the transceiver to a base when the call is established; and

c) retransmit the stored message through the transceiver when a playback command is received from a base through the transceiver, in response to an operator of the base depressing a keypad key.

24. The wireless device of claim 23, further comprising:
a geolocation receiver for determining position data for the device; and
the controller further programmed to:
d) transmit the position data through the transceiver when the call is established.

25. (Canceled)

26. A wireless device comprising:
a keypad;
a transceiver;
a memory, a message stored in the memory; and
a controller programmed to:

a) initiate a call from the wireless device in response to a key stroke;

b) initiate a timer when the call is established; and

c) transmit the stored message through the transceiver after a predetermined time has elapsed on the timer from when the call was established.

27. A wireless device comprising:
a keypad;
a transceiver;
a memory, a message stored in the memory; and
a controller programmed to:

a) initiate a call from the wireless device in response to a key stroke;

b) storing audio picked up by a microphone after initiating the call;

c) transmit the stored message through the transceiver to a base when the call is established; and

d) reallocate memory to store the audio picked up by the microphone after initiating the call.

28. The wireless device of claim 26 wherein the controller is further programmed to:

d) terminate transmission of the stored message when a voice signal is picked-up by a microphone of the wireless device.

29. The wireless device of claim 26 wherein the controller is further programmed to:

d) terminate transmission of the stored message when a key of the wireless device is activated.

30. A wireless device comprising:

a keypad;

a transducer;

a transceiver;

a memory, the memory storing a message; and

a controller programmed to:

a) initiate a call from the wireless device in response to a key stroke; and

b) combine the stored message with an audio signal from the transducer and transmit the combined signal simultaneously through the transceiver when the call is established.

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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) 872-~~9314~~ 9306 on March 9, 2004.

Laurence Cuyler

March 9, 2004
(Date)

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TRANSMITTAL OF APPEAL BRIEF

The enclosed brief is being filed in furtherance of the Notice of Appeal, filed via facsimile transmission on January 9, 2004.

In connection with filing the appeal brief, a total fee in the amount of $330 is believed to be due, which is the fee associated with filing an appeal brief, as provided by C.F.R. §1.17(c). The undersigned authorizes the Commissioner and respectfully requests that this fee be charged to deposit account 50-2117 of Motorola, Inc. The Commissioner is further authorized to charge any additional fees deemed to be necessary in connection with the proper handling and

consideration of the enclosed appeal brief in support of the appeal from the Examiner's final rejection, and/or credit any overpayments to deposit account 50-2117 of Motorola, Inc.

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Laurence Cluff

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